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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/882,127	06/15/2001	Assaf Govari	BIO-131	8639
27777	7590	12/14/2004		
PHILIP S. JOHNSON JOHNSON & JOHNSON ONE JOHNSON & JOHNSON PLAZA NEW BRUNSWICK, NJ 08933-7003			EXAMINER	SMITH, RUTH S
			ART UNIT	PAPER NUMBER
			3737	

DATE MAILED: 12/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/882,127	GOVARI, ASSAF
	Examiner	Art Unit
	Ruth S Smith	3737

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 26 November 2004.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,2,4,6-23,25 and 27-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,2,4,6-23,25 and 27-43 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 26 November 2004 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All
 - b) Some *
 - c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 26, 2004 has been entered.

Drawings

The drawings were received on November 26, 2004. These drawings are not acceptable. Figure 6 is not labeled as Table 1 as set forth in the specification.

Specification

The disclosure is objected to because of the following informalities: Reference to Table 1 as being shown in figure 6 is questioned in that no such labeling is seen in figure 6. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2, 4,7-11,21-23,25,28-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's admission of the prior art in view of von der Heide et al and Hinke et al or Normann. Applicant discloses that it is well known in the art to provide a medical device with a position sensor where the position sensor can determine position and orientation coordinates. Applicant further discloses that it is well

known to provide a magnetic field sensor as the position sensor. An example of such a sensor is disclosed by applicant to be a Hall Effect sensor. Von der Heide et al disclose in column 1, that well known types of magnetoelectronic position sensors include Hall effect sensors and Wiegand effect sensors. Hinke et al disclose a Wiegand effect sensor which comprises a core made of a Wiegand effect material and a winding positioned around the core. The sensor is disclosed as being used as a position sensor (column 2, lines 31-35). Normann discloses a magnetic field sensor which comprises a core made of a Wiegand effect material and a winding positioned around the core. With respect to the size of the position sensor, it appears that the size would be an obvious design choice based upon the type of application and given the use of such with a medical device, the sizes as set forth in the claims would have been obvious in order to allow such a combination to be inserted into a patient. The use of a Wiegand effect sensor would inherently provide the accuracy as set forth in the claims in view of the materials used. It would have been obvious to one skilled in the art to have modified the prior art disclosed by applicant such that the position sensor used is a Wiegand effect sensor. Such a modification involves the substitution of one well known type of magnetoelectronic position sensor for another. Furthermore, it would have been obvious to have constructed the sensor such that it comprises a core having a winding positioned around the core. The use of such a sensor involves the selection of one well known type of Wiegand sensor.

Claims 6,12-18,20,27,33-39,41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's admission of the prior art in view of von der Heide et al and Hinke et al or Normann as applied to claims 1,4,11,21,25,32 above, and further in view of Wiegand ('601). Wiegand discloses a Wiegand effect sensor having a core which comprises approximately 52% cobalt, 10% vanadium and 38% iron. The use of such materials will inherently result in the sensor having the properties as set forth in claims 5,6,20,26,27,41. It would have been obvious to one skilled in the art to have further modified the prior art disclosed by applicant such that the Wiegand sensor

comprises the materials as disclosed by Wiegand ('601). The modification merely involving the selection of a known type of materials for the core in the sensor.

Claims 19,40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's admission of the prior art in view of von der Heide et al and Hinke et al or Normann as applied to claims 9,30 above, and further in view of Yeoman. Yeoman discloses that it is known to provide a Wiegand sensing module comprising a core surrounded by a copper sensing winding (column 2, lines 21-25). It would have been obvious to one skilled in the art to have further modified the prior art disclosed by applicant such that the core is surrounded by a copper sensing winding as is well known in the art as taught by Yeoman.

Claims 21,25,28-32,41,42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's admission of the prior art in view of Honkura et al. Applicant discloses that it is well known in the art to provide a medical device with a position sensor where the position sensor can determine position and orientation coordinates. Applicant further discloses that it is well known to provide a magnetic field sensor as the position sensor. Honkura et al disclose the use of a copper, nickel, iron alloy as the material for a magnetic sensor. It would have been obvious to one skilled in the art to have modified the prior art disclosed by applicant such that the material used in the magnetic field sensor is a copper, nickel, iron alloy. Such a modification merely involves the substitution of one known type of material used in a magnetic sensor for another. The use of a such a position sensor would inherently provide the accuracy as set forth in the claims in view of the materials used. With respect to claim 41, the materials used would inherently provide the results set forth. With respect to the size of the position sensor, it appears that the size would be an obvious design choice based upon the type of application and given the use of such with a medical device, the sizes as set forth in the claims would have been obvious in order to allow such a combination to be inserted into a patient.

Claims 21,25,28-32,41-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's admission of the prior art in view of Chiriac et al. Applicant discloses that it is well known in the art to provide a medical device with a position sensor where the position sensor can determine position and orientation coordinates. Applicant further discloses that it is well known to provide a magnetic field sensor as the position sensor. Chiriac et al disclose the use of a copper, nickel, iron alloy or iron, chrome, cobalt as the material for a magnetic field sensor. It would have been obvious to one skilled in the art to have modified the prior art disclosed by applicant such that the material used in the magnetic field sensor is a copper, nickel, iron alloy or an iron, chrome, cobalt alloy. Such a modification merely involves the substitution of one known type of material used in a magnetic sensor for another. The use of such a position sensor would inherently provide the accuracy as set forth in the claims in view of the materials used. With respect to claim 41, the materials used would inherently provide the results set forth. With respect to the size of the position sensor, it appears that the size would be an obvious design choice based upon the type of application and given the use of such with a medical device, the sizes as set forth in the claims would have been obvious in order to allow such a combination to be inserted into a patient.

Response to Arguments

Applicant's arguments filed November 26 2004 have been fully considered but they are not persuasive. In response to applicant's argument that the prior art sensors cited are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the problem being dealt with pertains to determining position and orientation of an element. Therefore, one of ordinary skill in the art would look at any type of position sensor in any type of environment in order to

solve the problem. With respect to the accuracy of the sensor, the use of a Wiegand effect sensor would inherently provide the accuracy as set forth in the claims in view of the materials used. With respect to the size of the sensor, the sizes as set forth in the claims would have been obvious in order to allow such a combination to be inserted into a patient. It should be noted that applicant appears to merely argue that none of the references teaches the entire claimed invention. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Conclusion

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ruth S Smith whose telephone number is (571) 272-4745. The examiner can normally be reached on M-F 5:30 AM- 2:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on (571) 272-4956. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ruth S Smith
Primary Examiner
Art Unit 3737

RSS